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EXAMINER

YAGER, JAMES C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ATTACHMENT TO ADVISORY ACTION

Response to Amendment

1. The amendment filed 17 December 2008 will not be entered because it raises new issues requiring further consideration and search, namely the recitation that the non-woven web is "continuous" and that the trickle guard is wound "fully" circumferentially. Additionally, the amendment raises new issues that would require further consideration under 35 U.S.C. § 112, first paragraph for the recitation of "continuous" given that this term is not mentioned or defined in the specification. Although applicant points to the drawings for support, it is not clear how this provides support for reciting "continuous". The amendment raises new issues under 35 U.S.C. § 112, first paragraph for the recitation that the trickle guard is wound "fully" circumferentially given that while there is support to recite that the reinforcing layer is arranged over the entire circumference (P5/L7), there is no support to recite that the reinforcing layer is wound fully circumferentially around said pipe sleeve. The amendment also raises issues under 35 U.S.C. § 112, second paragraph for the recitation of "continuous" given that it is unclear what is meant by this term.
2. Even if the amendment were entered, it is the examiner's position that the present claims would not be allowable over the prior art for the reasons set forth below.

Response to Arguments

3. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

It is respectfully requested that the Final status of the outstanding rejection be withdrawn, because the rejection was made on prior art not of record, of a claim reasonably amended to include reasonably expected limitations. This action should not have been made final.

MPEP §706.07(a) states that "A second or any subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." In this case, the Seitz '845 patent is a new ground of rejection as the previous Office Action only cited GB Patent No. 1 214 330 to Baldwin-Ehret-Hill Inc., U.S. Patent No. 3,346,016 to Blau et al., U.S. Patent No. 3,824,140 to Hofmann, U.S. Patent No. 5,056,564 to Roth, U.S. Patent No. 4,576,206 to Lauren, and U.S. Patent No. 5,457,136 to Hartranft et al.

This new ground for rejection of claim 13 could not have been necessitated by Applicants' Amendment filed July 7, 2008 as Applicants merely rephrased the previously rejected claim 12 into the present claim 13, no new features were added to claim 13, and therefore no new subject matter was introduced (please see discussion in response to 112, first paragraph rejection with respect to newly presented claims 19 and 20). Contrary to the rule promulgated in the MPEP, the Examiner cited new art, as discussed above. Therefore, the finality of this action should be withdrawn.

MPEP §706.07(a) states:

706.07(a)Final Rejection, When Proper on Second Action

..., Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement ...

MPEP §706.07(a) further sets forth standard paragraph 7.40.01 and Note 1:

"Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL..."

Examiner Note:

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.

The new grounds were not necessitated by amendment, except for the fact that the amendment properly overcame the previous grounds for rejection. In other words the new grounds were not "necessitated by Applicant's amendment of the claims". (MPEP §706.07(a).)

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Therefore, a Final Rejection at this time would deny Applicants "a full and fair hearing, and that a clear issue between Applicants and examiner should be developed, if possible, before appeal."

Applicant's argument is unpersuasive because the new grounds of rejection of claim 13 was clearly necessitated by Applicant's amendment of 07 July 2008 given that the limitation which was added to claim 13 (i.e. "further characterized in that a reinforcing layer (13) in the form of a trickle guard is would circumferentially around it") was not present in claim 13 or any claim dependent from claim 13 as originally presented (no claims depend from claim 13 as originally presented). Although this limitation was present in claim 12, claim 12 depended from claim 9 not claim 13. Claim 13 as amended 07 July 2008 presented a new limitation necessitating new grounds of rejection. Therefore, the status of the outstanding rejection was properly designated as Final.

4. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

The B-E-H Inc. '330 patent discloses (page 3, lines 33-35) that "the pipe cover 10 is formed by spirally winding super-imposed mats of different fibrous materials into a tubular form...". Under correct consideration of the cited paragraphs on page 3, lines 35-40, Applicants respectfully submit that the complete teaching in this regard is that superimposed *mats* of different fibrous material are spirally wound into a two layer form with one layer being the outer layer and made of glass fibers, while the other layer creating the intermediate layers is made of mineral wool.

Given that a web is a sheet and that a mat is a sheet, it is the examiner's position that a mat is a web, absent evidence to the contrary.

5. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

Firstly, claim 9 has been amended to clarify that the nonwoven web is provided continuously, as supported in the original specification and figures, further reinforced through the use of first and second supply belts and a winding mandrel. Importantly, the specification of the presently claimed subject matter does not disclose the use of mats of material. Indeed, mats of

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material would not be easily implemented on such mechanisms without additional control systems, etc. Thus, the B-E-H Inc. '330 patent is at least deficient for the reason that it fails to disclose, teach or suggest "the pipe sleeve being formed of a wound continuous nonwoven web" as recited in amended claim 9.

The amendment to claim 9 has not been entered. However, even if the amendment were entered, it is the examiner's position that the mat of BEH is continuous given that it is an uninterrupted sheet.

Alternatively, since claim 9 is drawn to a pipe sleeve, although BEH does not disclose that the mat is continuous as claimed, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed continuous web and given that BEH meets the requirements of the claimed pipe sleeve, BEH clearly meet the requirements of present claim 9.

6. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

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Additionally, Applicants note that according to this piece of art, the process starts with two mats superimposed with each other. Applicants respectfully submit that if one were to put a couple of mats onto a mandrel and wind it thereon revolution by revolution, it is clear to someone of ordinary skill in the art that, because of the different diameters acting on each of the mats, the trailing ends thereof will not rest on the same place at the outside of the finished sleeve. In other words, the trailing end of the outer layer will rest at the sleeve body at a position where the trailing end of the inner layer is not reached. Thus, the outer layer of such construction typically does not completely surround the roll so that the second layer will be visible from the outside.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the outer layer of the construction completely surrounds the roll so that the second layer is not visible from the outside) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

Claim 9 has also been amended to include that the reinforcing layer is provided with means for allowing separation of wound layers in order to reduce external or internal diameter of the pipe. With respect to this feature, found in claim 18, rejected by the Examiner under Item 4 of the Office Action over the B-E-H Inc. '330 patent, Applicants note that although the Examiner has cited page 3, lines 40-45 "slit" of the B-E-H Inc. '330 patent as disclosing such features of previously presented claim 18, this Examiner referred to "slit" of the B-E-H Inc. '330 patent could be either "a longitudinally extending slit 12 through the sidewall" or "a partial slit 14 diametrically opposed therefrom" both of which "divid[ing] the pipe cover in halves 10a and 10b connected by a hinge 16 so that it may be opened as illustrated in Figure 4...". In either case, the slit may reduce external circumference of the pipe in that the pipe becomes halved, but with respect to the diameter of the pipe itself, neither an external or internal diameter is reduced resultingly.

Given the broad recitation that the means "is for allowing separation of wound layers in order to reduce external or internal diameter of the pipe" it is clear that a slit would "allow" one to reduce the internal or external diameter of the pipe by allowing one

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to roll one end at the slit under the other end, thereby decreasing the diameter of the pipe.

8. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

Also, Applicants note that no explicit teaching is given in the B-E-H Inc. '330 patent to provide a reinforcing layer at the outer circumferentially side of a sleeve body which is wound all around thereof. Moreover, no teaching is given that such outer layer may act as a trickle guard. The asserted reinforcing layer is not "*wound fully circumferentially* around the pipe," as recited in amended claim 9, due to the presence of the slits of the B-E-H Inc. '330 patent.

It is clear that since the reinforcing layer is made of the same material and has the same structure as the instantly claimed trickle guard, it is inherently a trickle guard.

Given that the reinforcing layer itself is wound fully around the pipe (Fig. 2), it is clear that it meets the limitations of claim 9. Although there is a slit in the pipe sleeve, there is no gap between the halves of the pipe sleeve and the two halves meet each other (Fig. 3). Therefore, the slits do not change the fact that the reinforcing layer is wound fully circumferentially around the pipe.

9. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

Further to the presently claimed subject matter, the B-E-H Inc. '330 patent is not fully enabling to disclose, teach or suggest that "at least one reinforcing layer..., is provided before the nonwoven web..., runs into the winder" as recited in independent claim 1. The Examiner has cited page 3, lines 35-40 and page 3, lines 55-60 of the B-E-H Inc. '330 patent as supporting such disclosure, but lines 35-40 disclose only that "the outer layer L_f and every other layer being made of glass fibre and the intermediate layers L_m between the glass fibre layers being made of mineral wool." Thus, the B-E-H Inc. '330 patent merely discloses that the outer layer and "every other layer" is made of a glass fibre, but does not discuss the composition of the inner most layer. Accordingly, the B-E-H Inc. '330 patent suggests that the composition of the inner most layer depends on whether the number of layers is odd or even. Applicants do not understand the applicability of the citation of lines 55-60 of the B-E-H Inc. '330 patent, which discuss the density of the finished cover and a comparison to "straight glass fibres," both elements that are not discussed in this portion of claim 1.

Claim 1 does not recite that the reinforcing layer is wound onto the winder before the non-woven web is wound onto the winder. Claim 1 merely recites that the reinforcing layer is *provided* before the non woven web runs into the winder. The BEH reference clearly meets the limitation that the reinforcing layer is *provided* before the non woven web runs into the winder given that the reinforcing layer is provided with the non-woven web before they are wound on the winder.

10. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

Admittedly, the B-E-H Inc. '330 patent does not disclose "that the reinforcing layer is

added to the trailing end of the nonwoven web" as recited in independent claim 1. Applicants note that the Examiner agrees that the B-E-H Inc. '330 patent does not disclose the features of claim 1 according to which the reinforcing layer is added to the trailing end of the nonwoven web. In this regard, he specifically refers to the Blau et al. '016 patent, asserting that such a feature is disclosed in column 5, lines 55-65. Applicants respectfully disagree with the Examiner. Applicants agree that the Blau et al. '016 patent teaches to roll a glass fiber felt on a mandrel, but disagree with the Examiner's interpretation that the Blau et al. '016 patent teaches "that at least one reinforcing layer is provided *before* the nonwoven web runs into the winder" (emphasis added) as recited in Applicants' claim 1. However, the Blau et al. '016 patent discloses (col. 5, lines 62-66) that "upon completion of the first revolution an aluminum foil will be inserted between the convolutions of the fiber felt with continuing the wrapping of the foil until five complete continuous spirals of foil are formed., whereupon the inclusion of the foil was terminated and the convoluting of glass fiber was continued..." (emphases added). This construction is shown in the figure of the Blau et al. '016 patent, wherein the metal foil is indicated by reference numeral 3 as described in col. 5, lines 33-47 of the Blau et al. '016 patent.

Hence, there is not only *no* disclosure in the Blau et al. '016 patent to add a reinforcing layer *before* the inclusion of nonwoven web in the pipe sleeve, but there is also *no* disclosure to add a reinforcing layer to the trailing end of the nonwoven web. In addition, the Blau et al. '016 patent does not disclose a pipe sleeve having a reinforcing layer arranged around the full circumference of the sleeve body.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. that the reinforcing layer is added before inclusion of the nonwoven web in the pipe sleeve) are not recited in the rejected claim(s). Although the claims are interpreted in

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light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Given the broad disclosure of "trailing end" and given that Blau discloses that the glass fiber layer is wound on a roll, then after one revolution, the reinforcing layer is wound onto the roll, it is clear that Blau discloses that the reinforcing layer is added to the trailing end of the glass fiber layer.

11. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

For example, with respect to dependent claim 7, Applicants respectfully disagree with the Examiner's citation of page 3, lines 80-85 of the B-E-H Inc. '330 patent as disclosing "that the reinforcing layer is wetted with additional binder before being provided for the winding operation." These lines of the B-E-H Inc. '330 patent discuss "mineral wool impregnated with a suitable thermosetting binder," which is notably not a reinforcing layer, and a few lines prior "glass fibre impregnated with a suitable thermosetting binder," but do not discuss any "that the reinforcing layer is wetted with *additional* binder." Thus, for at least this reason, the B-E-H Inc. '330 patent fails to teach, disclose or suggest the features of dependent claim 7.

Since no binder is recited as being present in the reinforcing layer other than the "additional binder" recited in claim 7, and the only other recitation of binder in the claims preceding claim 7 is the binder in the nonwoven web, it is the examiner's position that the binder recited in claim 7 is "additional" to the binder present in the nonwoven web. Given that both the reinforcing layer and nonwoven layer of BEH have binder in them, it is clear that the binder present in the reinforcing layer of BEH is "additional" to the binder present in the nonwoven layer and therefore meets the limitation of "additional binder".

12. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

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With respect to dependent claim 5, rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the B-E-H Inc. '330 patent in view of the Blau et al. '016 patent, as applied to claim 1 above, in view of the Hofmann '140 patent, Applicants submit that the Hofmann '140 patent fails to cure the deficiencies of the combination of the B-E-H Inc. '330 patent and the Blau et al. '016 patent with respect to independent claim 1, as discussed above. For example, the Hofmann '140 patent again discusses a split pipe sleeve, thereby unable to provide at least a "last layer arranged around the full circumference" as recited in Applicants' present claims. The Hofmann '140 patent even discusses that an additional "thin insulating layer 26 is inserted between the confronting faces of the sheath..." thereby further making it impossible for a "last layer to be arranged around the full circumference" as recited in Applicants' independent claim 1. Additionally, Applicants respectfully submit that while the Examiner's introduction of the Hofmann '140 patent is admittedly to address that "the reinforcing layer is applied to the mandrel before the winding of the nonwoven web in such a way that it provides the inner surface of the pipe sleeve determining the clear internal diameter of the pipe sleeve" as recited in Applicants' dependent claim 5, in contrast to the presently claimed subject matter, the "synthetic-resin foil sleeve 24" disclosed in col. 4, lines 1-4 which "the coiling mandrel is first provided with" is not of the same material as the "metal-foil layers 22"

which assertedly provide reinforcement layers to the "insulating fabric layers 21" of the Hofmann '140 patent. Thus, in addition to failing to cure the deficiencies of the previously discussed combination, the Hofmann '140 patent also fails to disclose that "*the* at least one reinforcing layer..., is applied to the winding mandrel..., *the* said reinforcing layer provides the inner surface of the pipe sleeve determining the clear internal diameter" as there is no consistency in the Hofmann '140 patent as to which 'reinforcement material' is used. Thus, for at least these reasons, the cited combination fails.

However, note that while Hofmann does not disclose all the features of the present claimed invention, Hofmann is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely that the reinforcing layer is applied to the mandrel before the winding of the nonwoven web in such a way that it provides the inner surface of the pipe sleeve determining the clear internal diameter of the pipe sleeve, and in combination with the primary reference, discloses the presently claimed invention.

13. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive. Applicant argues:

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With respect to claim 13, rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the Lauren '206 patent in view of the Seitz '845 patent, Applicants respectfully submit that the combination is improper and thus fails as col. 4, lines 64-64 of the Lauren '206 patent discloses that the "inner layer 3, which also consists of mineral wool" while page 2, lines **10-16** of the Seitz '845 patent discloses an "outer layer of glass wool." Thus, the combination not only fails to disclose use of the same material for the reinforcing layer, but further, fails to disclose as recited in amended claim 13, "said pipe sleeve further characterized in that the

reinforcing layer is one of or a combination of a glass nonwoven or a woven glass fibre fabric; or includes one of a particulate material, a particulate infrared radiation absorbing material or a particulate heat shielding material; or includes one of a foil material, or a heat reflective foil containing a metal; or is treated with a biocide agent."

Given that glass wool is made of glass and is not woven, it is the examiner's position that glass wool is a glass nonwoven fabric, absent evidence to the contrary.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES YAGER whose telephone number is (571)270-3880. The examiner can normally be reached on Mon - Thurs, 7:30am-5pm, EST, Alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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JY 01/06/09

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794